



511.40998X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: N. KOYAMA et al.

Serial No.: 10/018,188

Filed: DECEMBER 18, 2001

For: CMP ABRASIVE, METHOD FOR POLISHING SUBSTRATE
AND METHOD FOR MANUFACTURING SEMICONDUCTOR
DEVICE USING THE SAME, AND ADDITIVE FOR CMP
ABRASIVE

Group AU: 3724

Examiner: Timothy V. Eley

Confirm. No.: 7930

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Mail Stop: ISSUE FEE

Commissioner For Patents

P.O. Box 1450

Alexandria, VA 22313-1450

July 8, 2008

Sir:

In the attachment to the Notice of Allowability enclosed with the Notice of Allowance and Fee(s) Due mailed April 8, 2008, the Examiner states that Applicants' recitation of consisting essentially of "is interpreted as defining the CMP abrasive to contain only the recited components, and cannot contain any other components". Such interpretation by the Examiner of the phrase "consisting essentially of" is clearly improper under the guidelines of Manual of Patent Examining Procedure (MPEP) 2111.03. As is clear from the following, use of the "consisting essentially of" language permits the claims to include other components not materially affecting the basic and novel characteristics of the claimed subject matter.

Thus, note that MPEP 2111.03 states that the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and

those do not materially affect the basic and novel characteristics" of the claimed invention. This portion of the MPEP cites In re Hertz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).

MPEP 2111.03 goes on to state that a "consisting essentially of" claim occupies a middle ground between closed claims that are written in a "consisting of" format and fully open claims that are drafted in a "comprising" format. Thus, clearly the Examiner errs in interpreting Applicants' claims, reciting "consisting essentially of", as defining the CMP abrasive to contain only the recited components, and cannot contain any other components.

The claims as allowed are not limited to the recited components, wherein the abrasive "cannot contain any other components", as alleged by the Examiner, but rather the CMP abrasive as in the present claims can additionally include components that do not materially affect the basis and novel characteristics of the claimed invention.

In other words, the "consisting essentially of" language in the claims does not exclude all other components, and permits inclusion of components that do not materially affect the basic and novel characteristics of the claimed invention. With this proper interpretation of the "consisting essentially of" language, it is respectfully submitted that Applicants' claimed invention patentably distinguishes over the teachings of the prior art of record, as discussed during prosecution of the above-identified application, including, inter alia, in the Amendment filed March 12, 2007, therein.

Entry of the present comments of record in the above-identified application, is respectfully requested.

To the extent necessary, Applicants hereby petition for an extension of time under 37 CFR 1.136. Kindly charge any shortage of fees due in connection with the filing of this paper, including any extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Account No. 01-2135 (case 511.40998X00), and please credit any overpayments to such Deposit Account.

Respectfully submitted,

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